

REMARKS

In the present Amendment, the subject matter of claim 12 has been incorporated into claim 1, and claim 12 has been cancelled, accordingly.

No new matter has been added, and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 1-11 will be pending. Entry of the Amendment “after final” is proper, since Applicants are merely combining claims.

As an initial matter, it is stated in Paragraph No. 3 of the Action that “Claims 1-11 are present of which claim 11 is new.” The Examiner apparently overlooked claim 12. In the Amendment filed July 7, 2005, claims 1-12 were present, of which claims 11 and 12 were new.

In Paragraph No. 5 of the present Action, claims 1-11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Miyake et al (EP 909 657 A2).

Applicants submit that this rejection should be withdrawn because Miyake et al EP ‘657 does not disclose or render obvious the infrared-sensitive lithographic printing plate of the present invention.

Anticipation under §102 requires the disclosure in a single prior art reference of each and every element of the invention, arranged as in the claim. Stated differently, anticipation under §102 requires identity of invention.

Miyake et al EP ‘657 does not disclose the identical invention as claimed in the present claims, or fairly suggest it.

The Examiner relies on Paragraph [0028] of Miyake et al as disclosing that the copolymers of Miyake et al contained in the layer (A) of Miyake et al maybe used singly or in

combination. The Examiner maintains that when the polymers are used in combination, the recitations of the present claims would be met.

This, in Applicants' view, is not sufficient to support an anticipation. Applicants have reviewed the examples in Miyake et al EP '657, and it appears that there is not a single example in which the copolymers of Miyake et al were used in combination. See the various "Photosensitive solutions" used as coating solutions in the working Examples of Miyake et al, which begins at page 42, paragraph [0190] of Miyake et al.

Furthermore, the copolymer of Miyake et al EP '657 does not even necessarily contain a sulfonamide group. The layer (A) of Miyake et al contains at least one of the following monomers (a-1) to (a-3):

(a-1) a monomer having in the molecule a sulfonamide group wherein at least one hydrogen atom is linked to a nitrogen atom,

(a-2) a monomer having in the molecule an active amino group represented by general formula (I) shown at page 3 of Miyake et al, and

(a-3) a monomer selected from acrylimide, methacrylamide, acrylate, methacrylate and hydroxystyrene, which respectively have a phenolic hydroxyl group.

It appears to Applicants that only those copolymers which contain a monomer (a-1) of Miyake et al would include a sulfonamide group.

Further, the copolymers of Miyake et al do not necessarily contain a repeating unit based on the monomer of formula (I) shown in present claim 1. Miyake et al state at paragraph [0023] that the copolymer "may" include copolymerization components other than (a-1) to (a-3). As other copolymerization components, Miyake et al lists, beginning in paragraph [0024], many,

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many possibly monomers. While the monomers of formulas (IX), (X) and (XI) of Miyake et al would, if the substituents are selected with the proper hindsight, be within the scope of present formula (I) of claim 1, there is no requirement that such a monomer be selected from the many possible monomers listed at page 6 of Miyake et al.

The Examiner has not pointed to any reason why a person of ordinary skill in the art would have been motivated to select the particular monomers she has chosen, apparently based on hindsight, as opposed to or to the exclusion of all of the many other possible monomers disclosed in Miyake et al.

Miyake et al simply does not disclose or fairly suggest the infrared-sensitive lithographic printing plate of the present invention.

Still further, claim 1 has, in the present Amendment, been amended to incorporate the subject matter of claim 12. Claim 1 thus now recites that the copolymer (A) further has at least one monomer unit selected from the group consisting of (meth)acrylic acid esters and (meth)acrylamide derivatives.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the section 102(b) anticipation rejection of claims 1-11 based on Miyake et al EP '657.

In Paragraph No. 6 of the Action, claims 1-11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tomita et al (EP 1 219 464 A2).

Applicants submit that this rejection should be withdrawn because Tomita et al EP '464 does not disclose or render obvious the infrared-sensitive lithographic printing plate of the present invention.

It is true, as the Examiner states, that Tomita et al state that “The high molecular compounds which are transformed into alkali-soluble by heating may be alone or they may be used in combination of two or more.” See Tomita et al at paragraph [0128]. However, the Examiner has not pointed to a single example in Tomita et al where Tomita et al used a combination of such compounds, let alone a combination of such compounds which would satisfy the present claim limitations. Tomita et al does not identically disclose the present invention and does not anticipate the present claims.

Further, Tomita et al does not fairly suggest the present invention. Tomita et al, like Miyake et al, disclose at paragraphs [0121] through [0128] numerous monomers which may be employed in the so-called “high molecular compound” of Miyake et al. It is clearly an exercise in hindsight for the Examiner to pick and choose from the various monomers of Tomita et al to arrive at two copolymers, one of which would satisfy element (A) of the present claims, and the other of which would satisfy element (B) of the present claims.

Still further, as noted, claim 1 in the present Amendment has been amended to recite that the copolymer (A) further has at least one monomer unit selected from the group consisting of (meth)acrylic acid esters and (meth)acrylamide derivatives.

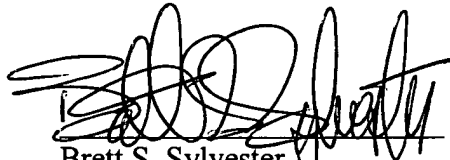
In view of the above, the Examiner is respectfully requested to reconsider and withdraw the section 102(b) anticipation rejection based on Tomita et al EP ‘464.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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